

REMARKS

The present Amendment is in response to the Official Action mailed July 13, 2006. Claims 1 and 4-6 have been amended. Claims 2, 3, 12 and 15-31 have been cancelled. Claims 32-40 have been added. Therefore, claims 1, 4-11, 13, 14, and 32-40 are currently pending in the present application. Applicant sets forth remarks relating to the Official Action below.

In response to the requirement for restriction previously required under 35 U.C.S. § 121, Applicant hereby affirms the previous election of claims 1-14, and claims 15-31 have been canceled accordingly. Nonetheless, Applicant reserves the right to pursue such canceled claims in any divisional and/or continuation cases relating to the present application.

In the Official Action, the Examiner first objected to the disclosure because of an informality in claim 4, line 4, where the Examiner asserted that the term "of" should be deleted. Dependent claim 4 has been amended accordingly, and such objections should be therefore removed.

Turning now to the substance of the Official Action, the Examiner first rejected claims 1, 2 and 12-14 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,355,061 to Bloebaum ("Bloebaum"). Essentially, it is the Examiner's position that FIGS. 19 and 20 of Bloebaum illustrate first and second blocks 60 and 62 which are slidable with respect to each other so that the device taught therein is expandable in a longitudinal direction. Applicant respectfully disagrees with the Examiner in regards to the Bloebaum reference. In the Applicant's opinion, Bloebaum teaches a device that relates to a cemented prosthetic component and placement method, and not an expandable augment trial for use with an orthopedic trial such as a femoral trial. In other

words, Bloebaum teaches an entire implant having two portions, and not an augment for use with an implant.

Further in the Official Action, the Examiner has also rejected claims 1-6 and 13 under 35 U.S.C. § 102(b) as being anticipated by PCT Application WO 01/89428 A2 to Sevrain ("Sevrain") and claims 1-3, 5-11 and 13 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2004/0019353 to Freid et al. ("Freid"). Essentially, it is the Examiner's opinion that both Sevrain and Freid teach all the limitations disclosed in the claims to which they are respectively applied. Without specifically setting forth each of the Examiner's contentions, Applicant notes that both Sevrain and Freid relate to apparatus for use in the spine. Such apparatus, have very different uses, and most specifically, are not designed to be utilized in conjunction with an orthopedic trial such as a femoral trial.

Finally, in the Official Action, the Examiner has also rejected claims 1, 2 and 12-14 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,571,194 to Gabriel ("Gabriel"). Although the Examiner does not specifically set forth any discussion relating to Gabriel, he notes that such reference teaches each and every one of the limitations of claims 1, 2 and 12-14, and specifically notes the abstract, drawings, and column 1, lines 40-43 of the reference as being particularly pertinent to the present invention. Applicant notes that the Gabriel reference is directed to a femoral augmentation system for an artificial knee joint. Although indeed more pertinent than the other references cited by the Examiner against the presently pending claims, Gabriel does not teach an orthopedic trial augment which anticipates the currently pending claims as amended herein. This will be discussed more fully below.

Independent claim 1 has been amended in the present response to include the limitations set forth in originally

presented dependent claims 2, 3 and 12. In the Applicant's opinion, the inclusion of the subject matter of dependent claim 12 in independent claim 1 clearly removes either Sevrain or Freid as anticipatory references against such claim. Clearly, those references relate to apparatus for use in the spine, and not a trial augment configured to be utilized with a femoral trial. In addition, the inclusion of the subject matter of dependent claims 2 and 3, allows independent claim 1 to overcome both Bloebaum and Gabriel. Specifically, independent claim 1 now requires that the orthopedic trial augment include "a first block and an expansion member including a second block slidably associated with the first block so that the trial is expandable in at least one direction, wherein the first and second blocks are biased such that the blocks expand in the at least one direction." Neither Bloebaum nor Gabriel teach such a construction.

As is mentioned above, Bloebaum teaches an entire implant having two portions and not an augment for use with an implant, and in fact, the two portions of the implant taught in Bloebaum are not biased with respect to one another. Gabriel, on the other hand, does in fact teach an expandable augment for use with an orthopedic trial, but does not teach or suggest the biasing requirement of amended independent claim 1. Rather, Gabriel teaches "a main augmentation block and a secondary block disposed within the main augmentation block. The secondary block is adjustably positioned within the main augmentation block such that relative motion between the two facilitates easy and secure fixture of the augmentation system within a prosthesis." See Abstract, lines 2-7. Gabriel also teaches "a screw that extends into the secondary block component [that] can be used to expand (or contract) the secondary block, relative to the first block, thus changing the overall width of the augmentation device such that the augmentation device securely

fits within the femoral component." See Column 2, lines 46-50. However, Gabriel does not teach any biasing element. Because of the lack of this teaching in Gabriel alone, such reference does not anticipate newly amended claim 1. Furthermore, the augment taught in Gabriel expands to change the overall width of the augmentation device, where the augmentation device of the present invention is in fact expandable to increase its length. Applicant respectfully points out that dependent claim 8 includes this length expanding limitation, which also overcomes the Gabriel reference.

Likewise, new claim 32 is similarly not anticipated or obviated in light of the cited prior art. Claim 32 includes certain of the limitations of allowable independent claim 1, with certain additional and/or different elements that, in Applicant's view, captures the contemplated invention and overcomes the cited prior art. For example, new claim 32 claims a trial augment configured to be utilized with a femoral trial, where the augment includes first and second blocks which are biased with respect to one another. This has been established above as patentable over the cited prior art. Furthermore, new dependent claim 33-40 have also been added and set forth additional elements to independent claim 32 and/or each other.

Therefore, in light of the above, Applicant respectfully submits that independent claim 1, as amended, and newly presented independent claim 32 clearly distinguish over the cited prior art. As such, Applicant respectfully requests that independent claim 1 and it's pending dependent claims 4-11, 13 and 14, and independent claim 32 and it's pending dependent claim 33-40 all be moved into a condition of allowance. While each of the pending dependent claims are not specifically discussed herein, their dependency upon allowable independent claims 1 or 32 necessarily makes them allowable. A dependent claim is narrower than its respective independent.

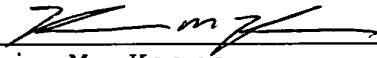
As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: October 13, 2006

Respectfully submitted,

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